

REMARKS

Before entry of this Amendment and Response, the status of the application according to the pending Office action is as follows:

- Claims 1-3, 8-11, 14, 15, 17, and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,901,473 to Heifort, IV (hereinafter “Heifort”).
- Claims 1-4, 14-17, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,517,928 to Shanahan (hereinafter “Shanahan”).
- Claims 5-7 and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Heifort or Shanahan.
- Claims 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Heifort in view of U.S. Patent No. 6,543,160 to Price (hereinafter “Price”).

Applicants hereby amend claim 1, without prejudice, as shown in the preceding Listing of Claims. Applicants hereby cancel claims 2-4, and add new claims 21 and 22. Support for new claims 21 and 22 can be found in the specification as originally filed, and at least at paragraphs [0030]-[0033]. No new matter is entered thereby. In view of the above amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of all grounds of rejection and passage of claims 1 and 5-22 to allowance.

1. Claims 1-3, 8-11, 14, 15, 17, and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by Heifort. Applicants have cancelled claims 2 and 3, thereby rendering the rejection moot with respect to those claims. Applicants respectfully traverse this rejection as applied to the remaining claims, as amended.

Briefly, Heifort appears to describe a weighted cleat 20 for a conventional athletic shoe

40, including a protective wear-resistant outer casing 22 defining an inner cavity 24, and a weighted core 26 retained with the inner cavity 24 for increasing the weight of cleat 20.

Additionally, the weighted cleat 20 includes a structure, such as a threaded post 34, for attaching the weighted cleat 20 to an athletic shoe. The weighted cleats 20 can be attached to conventional cleated athletic shoes 40 to increase an athlete's foot speed, leg strength and muscle tone, and overall endurance during training. Heifort, column 1 line 44 to column 2, line 65.

Applicants have amended claim 1 to include the subject matter of now cancelled claim 4, which was not rejected over Heifort. Accordingly, claim 1 is patentable over Heifort under 35 U.S.C. § 102(b). Because claims 8-11, 14, 15, 17, and 18 depend, either directly or indirectly, from independent claim 1, and include all of the limitations thereof, Applicants respectfully submit these claims are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3, 8-11, 14, 15, 17, and 18 under 35 U.S.C. §102(b) based on Heifort.

2. Claims 1-4, 14-17, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shanahan. Applicants have cancelled claims 2-4, thereby rendering the rejection moot with respect to those claims. Applicants respectfully traverse this rejection as applied to the remaining claims, as amended.

Briefly, Shanahan appears to describe a shoe including an upper 2, a weight receiving member 20, an inner sole 10, and a bottom sole 18. The weight receiving member 20 includes a number of openings 26a-e, 28a-b. Plugs 40 and weights 44, shaped to conform to the size and shape of one of the openings, can be placed in the openings 26a-e, 28a-b. The weights 44 can be selectively positioned and arranged within the shoe to produce desired results in the treatment of

various physical disorders. Shanahan, column 2, lines 8-68 and column 3, line 66 to column 4, line 1.

Applicants' amended independent claim 1 recites an article of footwear including a weight arranged in the sole unit, "*wherein the weight is substantially symmetrically distributed around at least one of an axis running generally through an area corresponding to first and second metatarso-phalangeal joints and an axis running generally through an area corresponding to third, fourth, and fifth metatarso-phalangeal joints of the foot.*" Applicants respectfully submit that Shanahan fails to teach or suggest such a structure, but rather teaches a shoe wherein weights can only be distributed at seven set locations to assist in the treatment of various physical disorders.

In Shanahan, a single, substantially semi-circular weight can be placed at the front of the weight receiving member, while the remaining weights are arranged on either side of a partition extending "*along the longitudinal center line of the weight receiving member.*" Shanahan, column 2, lines 40-63. Shanahan is silent on the exact placement of the lateral ribs dividing the openings for receiving the weights, and is silent on the placement of weights with respect to any axis running through the joints of a foot. More specifically, Shanahan is silent on the placement of weights with respect to an axis running generally through either the first and second metatarso-phalangeal joints or the third, fourth, and fifth metatarso-phalangeal joints of a foot.

Applicants' amended independent claim 1 further recites "*a weight arranged in the sole unit for stabilizing the foot against at least one torque acting on the foot when striking an object.*" Applicants respectfully submit that Shanahan fails to teach or suggest a weight arranged in the sole to stabilize the foot against at least one torque acting on the foot when striking an

object. Shanahan rather teaches a weighted shoe for use by physicians in treating various physical disorders and strengthening certain muscle groups. The shoe of Shanahan is not designed for “*striking an object*,” and as such there is no reason to arrange the weights of Shanahan to stabilize the foot against at least one torque acting on the foot when striking an object. Rather, the shoe of Shanahan is designed for medical purposes, and as such it may in fact be desired that “*striking an object*” be specifically avoided.

Thus, Shanahan does not teach or suggest an article of footwear including a weight arranged in the sole unit, “*wherein the weight is substantially symmetrically distributed around at least one of an axis running generally through an area corresponding to first and second metatarso-phalangeal joints and an axis running generally through an area corresponding to third, fourth, and fifth metatarso-phalangeal joints of the foot*,” as recited in Applicants’ amended independent claim 1. Nor does Shanahan teach or suggest “*a weight arranged in the sole unit for stabilizing the foot against at least one torque acting on the foot when striking an object*.” Accordingly, claim 1 is patentable over Shanahan under 35 U.S.C. § 102(b). Because claims 14-17 and 20 depend, either directly or indirectly, from independent claim 1, and include all of the limitations thereof, Applicants respectfully submit these claims are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-4, 14-17, and 20 under 35 U.S.C. §102(b) based on Shanahan.

3. Claims 5-7 and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Heifort or Shanahan. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Applicants amended independent claim 1 is patentable over either Heifort or Shanahan, at

least for the reasons discussed above. Because claims 5-7 and 11-13 depend, either directly or indirectly, from independent claim 1 and include all of the limitations thereof, Applicants respectfully submit these claims are allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 5-7 and 11-13 as being unpatentable over either Heifort or Shanahan.

4. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Heifort in view of Price. Applicants respectfully traverse this rejection as applied to the claim, as amended.

Briefly, Price appears to describe an apparatus including a shim 11 which is adapted to be interposed between the bottom 2 of a golf shoe 1 and a traction member 8 with which the shoe 1 is normally provided. The shim 11 can be interposed between a number of traction members 8 and the shoe bottom 2, causing the shimmed side of the shoe bottom 2 to occupy a level above the ground higher than that of the opposite side of the shoe 1. This can help in assisting a player to control his weight shift during the execution of a golf stroke. Price, column 2, line 41 to column 4, line 14.

Applicants respectfully submit that the disclosure of Price fails to cure the deficiencies of Heifort with respect to independent claim 1, as outlined in section 1 above. Specifically, Price fails to teach, suggest, or motivate one skilled in the art to arrive at an article of footwear comprising a weight, *“wherein the weight is substantially symmetrically distributed around at least one of an axis running generally through an area corresponding to first and second metatarso-phalangeal joints and an axis running generally through an area corresponding to third, fourth, and fifth metatarso-phalangeal joints of the foot.”*

Applicants therefore respectfully submit that neither Heifort nor Price, either alone or in proper combination, provides the teaching, suggestion, or motivation for one skilled in the art to arrive at Applicants' invention, as recited in independent claim 1. Because claim 19 depends indirectly from independent claim 1, and includes all of the limitations thereof, Applicants respectfully submit this claim is allowable as well.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Heifort in view of Price.

5. With this Amendment and Response, Applicants hereby add new claims 21 and 22. Claims 21 and 22 depend directly from amended independent claim 1 and are patentable for at least the reasons discussed hereinabove with respect to claim 1.

Applicants' new dependent claim 21 recites that "*the weight is substantially symmetrically distributed around the intersection of the axis running generally through an area corresponding to first and second metatarso-phalangeal joints and the axis running generally through an area corresponding to third, fourth, and fifth metatarso-phalangeal joints of the foot.*" Applicants respectfully submit that neither Heifort, Shanahan, nor Price, either alone or in proper combination, teaches or suggests such a structure, at least for the reasons discussed above.

Applicants' new dependent claim 22 recites that "*the weight is permanently embedded within the sole unit.*" Applicants respectfully submit that neither Heifort, Shanahan, nor Price, either alone or in proper combination, teaches or suggests such a structure, but rather Heifort, Shanahan, and Price all teach weights or shims that are releasably attached to, or placed within, a



shoe.

Applicants, therefore, submit that dependent claims 21 and 22 are independently allowable, at least for the reasons outlined above.

Accordingly, Applicants respectfully request allowance of new claim 21 and 22 in due course.

CONCLUSION

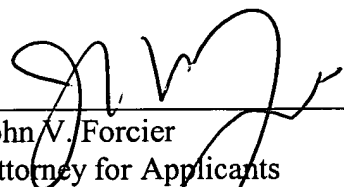
In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1 and 5-22 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,

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